12-12-05

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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Title:	"System and Method for Dynamically Adapting a Banner Advertisement to the Content of a Web Page"		
Applicant(s):	Reiner Kraft et al.		
Attorney Docket No.:	ARC9-2000-0100-US1		
Serial No.:	09/617,455	**Examiner:**	James W. Myhre
Filed:	07/17/2000	**Art Unit:**	3622

Board of Patent Appeals and Interferences
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450.

SUPPLEMENTAL APPEAL BRIEF

REQUEST FOR REINSTATEMENT OF APPEAL

Dear Sir:

This appeal brief is submitted under 35 U.S.C. §134, in response to the Notification of Non-Compliant Appeal Brief of November 8, 2005. This appeal is further to Appellants' Notice of Appeal filed on December 16, 2004. In response to the office action of September 17, 2004, Applicants respectfully request the reinstatement of the appeal.

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(1) Real Party in Interest

The real party in interest is International Business Machines Corporation.

(2) Related Appeals and Interferences

No other appeals or interferences exist that relate to the present application or appeal.

(3) Status of Claims

Claims 1 - 26 are pending, and remain in the application. In the Final Office Action of September 17, 2004, the claims were indicated to be rejected as follows:

- Claims 1-16 and 22-26 were rejected under 35 U.S.C. 101 on the ground that the claimed invention is directed to non-statutory subject matter.
- Claims 1-3, 17, 18, 22, and 23 were rejected under 35 U.S.C. 102(e) as being anticipated by Kurtzman II et al. (6,144,944).
- Claims 4-16, 19-21, and 24-26 were rejected under 35 U.S.C. 103(a) as being unpatentable over Kurtzman II et al (6,144,944).

(4) Status of Amendments

No amendments are outstanding.

(5) Summary of Claimed Subject Matter

The present invention relates in general to a software system and associated method for use in e-commerce advertising with a search engine over a network. More specifically, this invention pertains to a computer software product for **dynamically adapting a banner**

advertisement to the categorization, surrounding page content, and changes of the advertiser's repository. *Reference is made to Page 1, lines 6 - 13.*

5.1. Problems addressed by the present invention

Prior to presenting substantive arguments in favor of the allowability of the claims on file, it might be desirable to summarize the present invention in view of the problems it addresses. In general, banner ads can have text, still or moving graphics, or multimedia messages, and typically serve as hypertext links, such that the user is linked to other specified pages if the user clicks on the banner ads. Banner ads can be categorized as corporate image ads, and information ads.

The purpose of corporate image ads is to enhance the visibility and public image of a business enterprise, and to reflect its presence, participation and involvement in a particular domain. It is therefore crucial to prevent the misplacement of ads that disadvantageously affect the public image of an enterprise.

The information banner ads highlight a specific product, service, or content, and provide a URL to corresponding content information pages. The context placement of these banner ads is critical in that it needs to match the interests of potential customers. Currently, advertisers are able to select the surrounding content of the banner ads based primarily on the content categories.

For example, a developer portal wishes to advertise on a search service provider such as Yahoo!® in order to gain more traffic. Search service

providers offer a variety of categories where to place product or content ads. As an illustration, "software development", "Java®", "XML", etc. might constitute reasonable categories for an ad placement for the developer portal. **To place the same ad within a "Home & Garden" category would be a misplacement,** since the percentage of potential customers who are simultaneously seeking home and garden products and a software development product is not high.

Such misplacement is a common occurrence due in part to the static nature of the banner ad. As products and services of a company continue to change, it would be advantageous to have the banner ads automatically reflect these changes. As an example, for a data store carrying a variety of products and services, it would be desirable to have the newer or top rated products and services within specific categories automatically updated and displayed in the banner ads. Prior to the advent of the present invention, the most viable approach was for the advertiser to manually update the banner ads to reflect the desired products and services.

Such a "static approach" presents several disadvantages, among which are the following:

a) the selection might become obsolete after a short period of time; and

b) the maintenance effort to administer and manage the banner ads will be too high to support over an extended period of time. In particular, the problem of maintaining the banner ads content up to date becomes increasingly difficult for companies that provide a variety of different products and multimedia information within a repository that continuously

changes over a short time interval. Reference is made to page 1, line 15 through page 6, line 21.

5.2. Summary of the subject matter of independent claim 1

The adaptive advertising system 10 (FIGS. 1, 2, and 3) of the present invention **dynamically adapts the content of a banner ad 160 to the categorization, surrounding page content, and changes of the advertiser's repository of products and services.** In addition, the adaptive advertising system 10 provides appropriate information resources based on the user's needs.

As a result, the adaptive advertising system 10 provides the capability to serve advertisements with adaptive contents. This level of adaptivity ensures that the content of the banner advertisement reflects the current content of the web page where it is embedded, with a high degree of confidence. Advertisers using advertisements with adaptive content are relieved from the tedious and time and resource consuming task of having to repeatedly create new advertisements that are specifically designed for different page contents. The adaptive advertising system 10 will **automatically** adapt the advertisement to the continuously changing page content. *Reference is made to page 7, lines 20 - 22.*

Based on the page content, the adaptive advertising system 10 determines the desirability to display the banner advertisement 160. *Reference is made to page 16, lines 3 - 9.* If the content is inappropriate, the adaptive advertising system might decide not to display the banner advertisement to avoid an undesirable association between the banner advertisement and the page content. *Reference is made to page 16, lines*

11 - 15. **As an illustration**, consider an IBM advertisement within the "comp.programming" category being displayed nest to an article with an obscene content. IBM's corporate image might not be well served with such an undesirable association. The adaptive advertising system identifies this scenario, and disables itself, i.e., prevents the display of the banner ad, to avoid such a negative image association.

Therefore, the adaptive advertising system either displays or suppresses the banner ad based on the surrounding page content. This involves taking any one or more of the following steps:

a) Fine tuning the advertisement by showing the advertisement in the proper specialized category.

b) Replacing the category content.

c) The adaptive advertising system disables the advertisement until such time as the page content changes.

Transparently to the user, the system 10 continuously operates in the background to adapt banner advertisements based on the page content, surrounding content, and specific categorization or keywords provided by a domain specific repository. The system 10 is generally comprised of a banner display module 200, a keyword analyzer 210, an ad proxy router 212, an ad server 214, a banner advertising manager 220, an ad search engine 230, an indexer 252, an ad repository 240, an ad index repository 242, an advertiser site repository 244, and optionally a domain specific dictionary / repository 250. *Reference is made to page 15, line 20 through page 16, line 8.*

The keyword analyzer 210 analyzes the page content, and the banner display module 200 determines the desirability of associating the advertisement with the page. If the banner display module 200 determines that such an association does not adversely impact the advertiser's image, the banner display module 200 selectively displays the advertisement. Otherwise, the banner display module 200 suppresses the advertisement. *Reference is made to page 16, lines 10 - 24.*

The banner display module 200 sends a data stream containing the following information to the proxy router 212: the selected category; the keyword from the page; and the address of the ad server. In turn, the ad proxy router 212 sends the following information to the ad server 214: the session information; the selected category; and the keywords from the page.

The indexer 252 indexes the content of the advertiser's site, and stores the generated hyperlinks in the ad index repository. The ad repository stores the following: various advertisements from the advertiser; multimedia files; and executable codes or applications. *Reference is made to* pages 17 and 18 and FIG. 4.

In one embodiment, the advertisement includes a static portion such as the advertiser's logo, and a dynamic portion. The dynamic portion can be any one or more of: multimedia files; advertisements, executable codes, or hypertext links.

5.3. Summary of the subject matter of independent claim 17

While claim 1 exemplifies the present invention in connection with a system for dynamically adapting an advertisement based on a content of a page, claim 17 generally corresponds to claim 1, and exemplifies the present invention in connection with a computer program product for dynamically adapting an advertisement based on a content of a page.

5.4. Summary of the subject matter of independent claim 22

While claim 1 exemplifies the present invention in connection with a system for dynamically adapting an advertisement based on a content of a page, claim 22 generally corresponds to claim 1, and exemplifies the present invention in connection with a method for dynamically adapting an advertisement based on a content of a page.

(6) Grounds of Rejection to be Reviewed on Appeal

Appellant respectfully traverses the following grounds of rejection and request that they be reviewed on appeal:

6.1. First Ground of Rejection

- Claims 1-16 and 22-26 stand rejected under 35 U.S.C. 101 on the ground that the claimed invention is directed to non-statutory subject matter.

6.2. Second Ground of Rejection

- Claims 1-3, 17, 18, 22, and 23 stand rejected as being are anticipated under 35 U.S.C. 102, by Kurtzman II et al (6,144,944).

6.3. Third Ground of Rejection

- Claims 4-16, 19-21, and 24-26 stand rejected as being obvious in view of Kurtzman II et al (6,144,944).

(7) Arguments

7.A. Argument Responding to the First Ground of Rejection

The Examiner rejected claims 1-16 and 22-26 under 35 U.S.C. 101 on the ground that the claimed invention is directed to non-statutory subject matter, reasoning that:

> "In the present application, the above claims do not clearly indicate what steps or features are being performed by technology, such as a computer or through a computer network. For example, in Claim 1 **a keyword analyzer could be a person** scanning the content of a printed page, **the module for determining the desirability of an advertisement could also be the same or a different person mentally matching** the page's content with available advertisements, **and then displaying** (showing) the selected advertisement to someone (presumably a potential customer). In order to overcome this rejection, the Examiner suggests the Applicant amend the terminology in the claims to more clearly indicate which steps are being performed by what type of technology, such as "an electronic keyword analyzer for..."; an electronic banner display module for automatically determining..."; and "the electronic banner display module selectively displaying at least a portion of the advertisement on a display screen if...". The Examiner also notes that the claimed "page" should be changed to "web page" or "electronic page" to clarify the environment in which the system is operating." Emphasis added.

Applicants refer to, and incorporate herein by reference, MPEP Sections 2106 and 2107 and the legal authorities cited therein, and particularly the following excerpts:

"The claimed invention as a whole must accomplish a **practical application**.
The written description will provide the clearest explanation of the applicant's invention, by exemplifying the invention, explaining how it relates to the prior art and explaining the relative significance of various features of the invention.
Claims to computer-related inventions that are clearly nonstatutory fall into the same general categories as nonstatutory claims in other arts, namely natural phenomena such as magnetism, and abstract ideas or laws of nature which constitute "descriptive material."
In practical terms, claims define nonstatutory processes if they:
- consist solely of mathematical operations without some claimed **practical application** (i.e., executing a "mathematical algorithm"); or
- simply manipulate abstract ideas, e.g., a bid (Schrader, 22 F.3d at 293-94, 30 USPQ2d at 1458-59) or a bubble hierarchy (Warmerdam, 33 F.3d at 1360, 31 USPQ2d at 1759), without some claimed practical application." (Emphasis added).

Applicants respectfully traverse the foregoing rejection and submit that **ALL** the rejected claims present sufficient structural support and practical and useful application, which obviate the need to amend the claim language to basically add the term "electronic" to qualify the terms. In particular, the Summary of the Invention above, as well as the application clearly explain that the components in the rejected claims are computer components and not users. More specifically, the application makes repeated reference to the "automatic" function of these components, thus clearly distinguishing over the "manual" function performed by a user. Since, as explained earlier, the written description provides the clearest explanation of the applicant's invention, Applicants respectfully request that the terms not be redefined, and that their meanings be maintained

within their reasonable bounds, as intended by Applicants in the application.

Applicants will now consider only the representative claim 1, with the understanding that all the rejected claims present similar structural and application support under 35 U.S.C. 101. Claim 1 provides as follows, with emphasis added:

> "1. A system for dynamically adapting an advertisement based on a content of a page, comprising:
> **a keyword analyzer** for analyzing the page content;
> **a banner display module** for determining a desirability of associating the advertisement with the page; and
> **the banner display module** selectively displaying at least a portion of the advertisement if an association between the advertisement and the page is determined to be desirable."

Applicants submit that representative claim 1 clearly recites two main structural elements: a keyword analyzer 210 and a banner display module 200. It eludes Applicants' reasonable understanding how the examiner could analogize the keyword analyzer and the banner display module to persons while the invention, as consistently described, refers to physical structures that perform automatic functions.

Therefore, Applicants submit that all the rejected claims are in compliance with 35 U.S.C. 101.

7.B. Argument Responding to the Second Ground of Rejection

Claims 1-3, 17, 18, 22, and 23 were rejected under 35 U.S.C. 102(e) as being anticipated by Kurtzman II et al (6,144,944), reasoning as follows:

> "Claims 1, 17, and 22: Kurtzman discloses a system, method and program for adapting an advertisement based on the content of a page, comprising:
> a. analyzing the page content (col 4, lines 50-57);
> b. determining the desirability of the advertisement with the page (col 4, lines 32-34); and
> c. displaying at least a portion of the desirable advertisement (col 5, lines 44-50).
> Claims 2, 3, 18, and 23: Kurtzman discloses a system, method, and program for adapting an advertisement based on the content of a page as in Claims 1, 17, and 22 above, and further discloses not displaying inappropriate advertisements (col 23, lines 48-49) and displaying a first portion of the advertisement pending retrieval of a second portion of the advertisement (col 7, lines 32-39)."

Applicants respectfully traverse this rejection and submit that the rejected claims are not anticipated by Kurtzman. In support of this position, Applicants submit the following arguments.

(a). Legal Standard for Lack of Novelty (Anticipation)

The standard for lack of novelty, that is, for "anticipation," is one of strict identity. To anticipate a claim for a patent, a **single prior source must contain** all its essential elements, and the burden of proving such anticipation is on the party making such assertion of anticipation. Anticipation cannot be shown by combining more than one reference to show the elements of the claimed invention. The amount of newness and usefulness need only be minuscule to avoid a finding of lack of novelty.

The following are two court opinions in support of Applicants' position of non anticipation, with emphasis added for clarity purposes:

- "Anticipation under Section 102 can be found only if a reference shows **exactly** what is claimed; where there are **differences** between the reference disclosures and the claim, a rejection must be based on obviousness under Section 103." *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985).

- "**Absence** from a cited reference **of any element** of a claim of a patent negates anticipation of that claim by the reference." *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 230 USPQ 81 (Fed. Cir. 1986), on rehearing, 231 USPQ 160 (Fed. Cir. 1986).

(b). Application of the Anticipation Standard

The Examiner refers to column 4, lines 32-34 of Kurtzman, which excerpt is reproduced below with emphasis added:

> "The affinity of an attribute to an object is determined by comparing the attribute to an affinity criterion associated with the object. For instance, a **user's** demographic attribute would be compared to an advertisement's demographic criterion in order to measure the demographic affinity **of the user** to the advertisement."

Applicants respectfully submit that the foregoing excerpt clearly illustrates the distinction between the prior art and the present invention. In Kurtzman the comparison is based on **the user's demographic affinity**. On the other hand, Claims 1, 17 and 22 recite determining the association of **the advertisement** with the **page**, regardless of the user, the user's affinity, or the user's demographic data. It is not clear how such irrelevant information causes the present invention to be anticipated, particularly that the relevant language of the claims has not been addressed. In particular, the Examiner did not cite a reference that

bases the association of the advertisement on the content of the page.

Regarding the rejection ground of claims 2, 3, 18, and 23, stating that "Kurtzman discloses a system, method, and program for adapting an advertisement **based on the content of a page** as in Claims 1, 17, and 22 above, and further discloses not displaying inappropriate advertisements," Applicants reiterate that Kurtzman does not base the **adaptation of the advertisement based on the content of a page**, as stated by the Examiner. As a result, the selective display in Kurtzman is not based on the **adaptation of the advertisement relative to the content of a page**, but, as explained earlier, the selective display is based on the user's demographic affinity.

To conclude, claims 1-3, 17, 18, 22, and 23 are not anticipated by Kurtzman, and the allowance of these claims is respectfully requested.

7.C. Argument Responding to the Third Ground of Rejection

Claims 4-16, 19-21, and 24-26 were rejected under 35 U.S.C. 103(a) as being unpatentable over Kurtzman II et al (6,144,944). Applicants respectfully traverse this rejection and submit the following supporting arguments.

(a). Legal Standard for Obviousness

The following legal authorities set the general legal standards in support of Applicant's position of non obviousness, with emphasis added for added clarity:

- MPEP 706.02(j), "**To establish a prima facie case of obviousness, three basic criteria must be met.** First, there must be some suggestion or motivation, either in the references themselves or in the knowledge

generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, **the prior art reference (or references when combined) must teach or suggest all the claim limitations**. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) ... The initial burden is on the examiner to provide some **suggestion of the desirability** of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the **references must expressly or impliedly suggest the claimed invention** or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985)."

- **In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is** not whether the differences themselves would have been obvious, but **whether the claimed invention as a whole would have been obvious**. The prior art perceived a need for mechanisms to dampen resonance, whereas the inventor eliminated the need for dampening via the one-piece gapless support structure. "Because that insight was contrary to the understandings and expectations of the art, the structure effectuating it would not have been obvious to those skilled in the art." 713 F.2d at 785, 218 USPQ at 700 (citations omitted).

- MPEP §2143.03, "All Claim Limitations Must Be Taught or Suggested: To establish prima facie obviousness of a claimed invention, **all the claim limitations must be taught or suggested by the prior art**. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "**All words in a claim must be considered** in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)."

- MPEP §2143.01, "The Prior Art Must Suggest The Desirability Of The Claimed Invention: There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill

in the art." In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) (**The combination of the references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a prima facie case of obvious was held improper**.). The level of skill in the art cannot be relied upon to provide the suggestion to combine references. Al-Site Corp. v. VSI Int'l Inc., 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999).

- "**Obviousness cannot be established** by combining the teachings of the prior art to produce the claimed invention, **absent some teaching or suggestion** supporting the combination." *In re Fine, 837 F.2d at 1075, 5 USPQ2d at 1598* (citing *ACS Hosp. Sys. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)).* **What a reference teaches** and whether it teaches toward or **away from the claimed invention** are questions of fact. See *Raytheon Co. v. Roper Corp., 724 F.2d 951, 960-61, 220 USPQ 592, 599-600 (Fed. Cir. 1983),* cert. denied, *469 U.S. 835, 83 L. Ed. 2d 69, 105 S. Ct. 127 (1984).* "

- "When a rejection depends on a combination of prior art references, there must be **some teaching, suggestion, or motivation** to combine the references. See *In re Geiger*, 815 F.2d 686, 688, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987)." Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention **where there is some teaching, suggestion, or motivation** to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See MPEP 2143.01; In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000); In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); and In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

- "With respect to core factual findings in a determination of patentability, however, the **Board cannot simply reach conclusions based on its own understanding or experience** -- or on its assessment of what would be basic knowledge or common sense. **Rather, the Board must point to some concrete evidence in the record** in support of these findings." See In re Zurko, 258 F.3d 1379 (Fed. Cir. 2001).

- "We have noted that **evidence of a suggestion, teaching, or motivation to combine** may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved, see Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir.

1996), Para-Ordinance Mfg. v. SGS Imports Intern., Inc., 73 F.3d 1085, 1088, 37 USPQ2d 1237, 1240 (Fed. Cir. 1995), although "the suggestion more often comes from the teachings of the pertinent references," Rouffet, 149 F.3d at 1355, 47 USPQ2d at 1456. The range of sources available, however, does not diminish the requirement for actual evidence. That is, **the showing must be clear and particular**. See, e.g., C.R. Bard, 157 F.3d at 1352, 48 USPQ2d at 1232. **Broad conclusory statements regarding the teaching of multiple references, standing alone, are not "evidence."** E.g., McElmurry v. Arkansas Power & Light Co., 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993) ("Mere denials and conclusory statements, however, are not sufficient to establish a genuine issue of material fact."); In re Sichert, 566 F.2d 1154, 1164, 196 USPQ 209, 217 (CCPA 1977)." See In re Dembiczak, 175 F. 3d 994 (Fed. Cir. 1999).

- "To prevent the use of hindsight based on the invention to defeat patentability of the invention, **this court requires the examiner to show a motivation to combine the references** that create the case of obviousness. In other words, **the examiner must show reasons** that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references **for combination in the manner claimed**." See In re Rouffet, 149, F.3d 1350 (Fed. Cir. 1998).

- The mere fact that references can be combined or modified does not render the resultant combination obvious **unless the prior art also suggests the desirability of the combination**. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, **there must be a suggestion or motivation in the reference** to do so." 916 F.2d at 682, 16 USPQ2d at 1432.). See also In re Fritch, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992) (flexible landscape edging device which is conformable to a ground surface of varying slope not suggested by combination of prior art references).

- If the **proposed modification would render the prior art invention being modified unsatisfactory** for its intended purpose, then there is no suggestion or motivation to make the proposed modification. In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

(b). Application of the Obviousness Standard

The Examiner presented the following ground in support of the obviousness rejection, with emphasis added:

> "Claims 4-7, 19, and 24: Kurtzman discloses a system, method, and program for adapting an advertisement based on the content of a page as in Claims 3, 18, and 23 above, and further discloses displaying static or dynamic portions of an advertisement, multimedia file, executable code or hyperlink (col 2, lines 14-17 and 53-58). However, **Kurtzman does not explicitly disclose that the first portion of the advertisement is a static portion which includes an advertiser's logo**. **Official Notice is taken that it is old and well known** within the marketing arts to disclose static symbols or text (such as "Downloading") to a user while a file is being downloaded through a network. **It is also well known** for a company or advertiser to display its logo, such as has been done by network television stations displaying their call sign and logo during periods of non-reception or outages. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to display a static message, such as a logo, to the user while the system was waiting for the rest of the advertisement (such as Kurtzman's video advertisement) to finish downloading. One would have been motivated to display such a static logo while waiting for the rest of the advertisement to download in order to prevent the user being presented with a "blank" screen during the wait time."

It appears that the Examiner is relying on, and taking official notice of his personal experience to formulate the rejection ground. However, the Examiner has not provided any evidence in support of the official notice. As a result, the rejection is deficient, and needs to be either withdrawn or additional evidence needs to be provided to support the rejection.

Nonetheless, assuming for the sake of arguments only that this rejection ground is acceptable, and that an advertisement includes a static portion,

according to the present invention, such static portion would be displayed if, for example, the page content does not disadvantageously affect the advertiser's image, pending a retrieval of a second portion of the advertisement. Refer for example to claim 4 that depends on claim 3. The examiner's rejection is silent as to such determining prior to displaying the static portion of the advertisement, it being clearly understood that the invention must be considered as a whole and not dissected, as required by the legal authorities above.

To conclude, claims 4-7, 19, and 24 are not obvious in view of Kurtzman and the official notice considered by the Examiner, and the allowance of these claims is respectfully requested.

7.D. Argument Responding to the Notification of November 8, 2005

Section 8 of the Notification objects to the Appeal Brief for not attaching evidence entered by the examiner and relied upon by Appellants in the appeal. Applicants submit herewith, out of abundance of caution, as *Appendix B*, the "Examiner Affidavit Supporting Obviousness Rejection" that was submitted by the Examiner in the final office action of February 19, 2004. Appellants respectfully submit that such an affidavit is not required, since the Appellants do not rely on this affidavit in the present Appeal Brief. It should be noted that the appended Affidavit is not signed by the Examiner and was submitted by the previous Examiner in charge of this case, who apparently is no longer in charge of this case: Stephen Michael Gravini.

Section 8 of the Notification objects to the Appeal Brief for not containing copies of the decisions rendered by a court or the Board in the proceeding identified in the Related Appeals and Interferences section. Appellants respectfully submit that no such related decisions have been rendered, as indicated in *Appendix C*.

Respectfully submitted,

Date: December 8, 2005

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APPENDIX A

CLAIMS ON APPEAL

1. A system for dynamically adapting an advertisement based on a content of a page, comprising:

a keyword analyzer for analyzing the page content;

a banner display module for determining a desirability of associating the advertisement with the page; and

the banner display module selectively displaying at least a portion of the advertisement if an association between the advertisement and the page is determined to be desirable.

2. The system according to claim 1, wherein if the banner display module determines the association to be inappropriate relative to the page content, the banner display module suppresses the advertisement.

3. The system according to claim 2, wherein if the banner display module determines that the advertisement can be displayed without disadvantageously affecting an advertiser's image, the banner display module displays a first portion of the advertisement, pending a retrieval of a second portion of the advertisement.

4. The system according to claim 3, wherein the first portion of the advertisement is a static portion.

5. The system according to claim 4, wherein the second portion of the advertisement is a dynamic portion.

6. The system according to claim 4, wherein the static portion includes an advertiser's logo.

7. The system according to claim 5, wherein the dynamic portion is any one or more of: a multimedia file; an advertisement, an executable code, or a hypertext link.

8. The system according to claim 7, further including an ad server that serves an advertiser's site; and

wherein the ad server has an address.

9. The system according to claim 7, wherein the keyword analyzer specifies a selected category for the advertisement based on the page content.

10. The system according to claim 9, further including an ad proxy router; and

wherein the banner display module sends a data stream containing the following information to the proxy router:

the selected category;

at least one keyword from the page; and

the address of the ad server.

11. The system according to claim 10, wherein the ad proxy router sends the following information to the ad server:

session information;

the selected category; and

the at least one keyword from the page.

12. The system according to claim 8, wherein the advertiser's site includes a banner advertising manager.

13. The system according to claim 12, wherein the advertiser's site further includes an indexer for indexing the content of the advertiser's site, and for generating a plurality of hyperlinks therefrom; and

an ad index repository for storing the hyperlinks.

14. The system according to claim 13, wherein the advertiser's site further includes an ad repository for storing any one or more of the following:

an advertisement;

a multimedia file; or

an executable code.

15. The system according to claim 9, wherein the page is classified under a current category; and

wherein the banner display module compares the current category and the selected category, and selects either the current category or the selected category.

16. The system according to claim 15, further including a domain specific dictionary for refining the selected category.

17. A computer program product for dynamically adapting an advertisement based on a content of a page, comprising:

a keyword analyzer for analyzing the page content;

a banner display module for determining a desirability of associating the advertisement with the page; and

the banner display module selectively displaying at least a portion of the advertisement if an association between the advertisement and the page is determined to be desirable.

18. The computer program product according to claim 17, wherein if the banner display module determines the association to be inappropriate relative to the page content, the banner display module suppresses the advertisement; and

wherein if the banner display module determines that the advertisement can be displayed without disadvantageously affecting an advertiser's image, the banner display module displays a first portion of the advertisement, pending a retrieval of a second portion of the advertisement.

19. The computer program product according to claim 18, wherein the first portion of the advertisement is a static portion;

wherein the static portion includes an advertiser's logo;

wherein the second portion of the advertisement is a dynamic portion; and

wherein the dynamic portion is any one or more of: a multimedia file; an advertisement, an executable code, or a hypertext link.

20. The computer program product according to claim 19, further including an ad server that serves an advertiser's site;

wherein the ad server has an address; and

wherein the keyword analyzer specifies a selected category for the advertisement based on the page content.

21. The computer program product according to claim 20, further including an ad proxy router;

wherein the banner display module sends a data stream containing the following information to the proxy router:

the selected category;

at least one keyword from the page; and

an address of the ad server; and

wherein the ad proxy router sends the following information to the ad server:

session information;

the selected category; and

the at least one keyword from the page.

22. A method for dynamically adapting an advertisement based on a content of a page, comprising:

a keyword analyzer for analyzing the page content;

a banner display module for determining a desirability of associating the advertisement with the page; and

the banner display module selectively displaying at least a portion of the advertisement if an association between the advertisement and the page is determined to be desirable.

23. The method according to claim 22, wherein if the association of the advertisement is determined to be inappropriate relative to the page content, the banner display module suppressing the advertisement; and

if the association of the advertisement is determined to be appropriate relative to the page content, the banner display module displaying a first portion of the advertisement, pending a retrieval of a second portion of the advertisement.

24. The method according to claim 23, further including displaying the second portion;

wherein the first portion of the advertisement is a static portion;

wherein the static portion includes an advertiser's logo;

wherein the second portion of the advertisement is a dynamic portion; and

wherein the dynamic portion is any one or more of: a multimedia file; an advertisement, an executable code, or a hypertext link.

25. The method according to claim 24, further including the keyword analyzer specifying a selected category for the advertisement based on the page content.

26. The method according to claim 25, further including the banner display module sending a data stream containing the following information to a proxy router:

the selected category;

at least one keyword from the page; and

an address of an ad server; and

wherein the ad proxy router sends the following information to the ad server:

session information;

the selected category; and

the at least one keyword from the page.

Appendix B Examiner Affidavit

EXAMINER AFFIDAVIT SUPPORTING OBVIOUSNESS REJECTION

Claims 1-26 are an obvious variation over examiner's personal experience of an apparatus or method for dynamically adapting an advertisement based on page content as provided by completing a consumer product questionnaire, such as those associated with consumer product registration, consumer surveys, or the like. The claimed page content, advertisement, and banner are considered non-functional descriptive material, which will be discussed infra. The claimed keyword analyzer, banner display module, and ad server are considered automated features of an old and well known manual operation, which will also be discussed infra. The claimed apparatus or method are considered to be patentably equivalent to the examiner receiving a product or survey questionnaire related to a consumer product purchase or magazine subscription for targeted advertising based on preference selections made on that questionnaire based on the broadest reading of the claims under the *Graham* decision. Since at least 1994, examiner has experience with the claimed invention as a consumer. The claimed apparatus or method comprising:

a keyword analyzer for analyzing page content;

a banner display module for determining the desirability of associating an advertisement with the page; and

the banner display module selectively displaying at least a portion of the advertisement if an association between the advertisement and the page is determined to be desirable are part of examiner's personal experience. Examiner's personal experience also includes the claimed first static portion along with a second dynamic

portion advertisement display affecting advertiser image, advertiser logo, multimedia file, executable code, or hypertext link, ad server address, proxy router, session information, advertising manager, index repository, current category classification, and domain specific dictionary. The claimed keyword analyzer for analyzing page content is considered functionally equivalent to blocks marked in a product questionnaire such that a later analyzer may use examiner selected information for questionnaire purposes. The claimed banner display module for determining the desirability of associating an advertisement with the page is considered functionally equivalent the examiner questionnaire selections such as interest in swimming, running, cycling, and camping so that the information would allow a banner display module to associate those selections with the desirability of outdoor activities, sports, and/or athletic participation for advertisement targeting. The claimed banner display module selectively displaying at least a portion of the advertisement if an association between the advertisement and the page is determined to be desirable is considered functionally equivalent to examiner receiving telemarketing calls, postal advertisement mailings, and/or non-automated display of a portion of an advertisement associated with the questionnaire selection page for examiner desired advertisements. The claimed first static portion along with a second dynamic portion advertisement display affecting advertiser image, advertiser logo, multimedia file, executable code, or hypertext link, ad server address, proxy router, session information, advertising manager, index repository, current category classification, and domain specific dictionary are old and well known to those skilled in similar areas of examiner experience and are considered part of consumer

questionnaire participation included in examiner's experience. The claimed invention has been performed by the examiner long before the filing of the present invention except for the specifically recited page content, advertisement, and banner. Those recitations are considered non-functional descriptive language and can not be given patentable weight. It would have been obvious to those skilled in the art of the claimed method or system to use those recitations to seek patent protection. The non-functional descriptive language including page content, advertisement, and banner are considered merely information or data item necessary to provide an accounting for establishing and maintaining an information basis in the field of endeavor claimed by the applicant. This non-functional descriptive language difference is only found in the nonfunctional descriptive material and is not functionally involved in the steps recited. The claimed page content, advertisement, and banner would be performed the same regardless of the data or information. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability. Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to claim an apparatus or method particularly page content, advertisement, and banner, because such data or information does not functionally relate to the steps in the invention claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention. Also, the claimed invention contains automated features, such as keyword analyzer, banner display module, and ad server which are obvious variations to the examiner's experience that is so old and well known that the examiner will use Official notice to obviate that claimed subject matter. The

keyword analyzer, banner display module, and ad server, as discussed in the specification, are interpreted to encompass automated electronic communications associated with electronic mail, Internet, and/or computer to server communications. The claimed invention, recited by the applicant, has been provided to examiner by personal experience long before the filing of applicant's invention. Examiner notes that it is old and well known to those skilled in the art of the claimed apparatus or method, that it would have been obvious to claim the invention as recited by the applicants, in order to overcome the explicit teachings of examiner's personal experience discussed supra. It would have been obvious to one skilled in the art to provide the automated claimed apparatus or method since those features, particularly keyword analyzer, banner display module, and ad server, are merely automated features of a concept that is old and well known. The motivation to combine applicants' claimed invention with the services offered by consumer product questionnaires, under examiner experience is to allow greater consumer targeting capabilities through electronic mediums, while transferring information, which clearly shows the obviousness of the claimed invention.

I hereby declare that all statements made under this declaration of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment or both, under 18 USC 1001 and that such will false statements may jeopardize the validity of the application or any patent issued thereon.

Appendix C

Related Decisions by a Court of the Board

None

PTO/SB/17 (12-04v2)
Approved for use through 07/31/2006. OMB 0651-0032
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Effective on 12/08/2004.
Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818).

FEE TRANSMITTAL
For FY 2005

☐ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT	($)	0

Complete if Known	
Application Number	09/617,455
Filing Date	07/17/2000
First Named Inventor	Reiner Kraft et al.
Examiner Name	James W. Myhre
Art Unit	3622
Attorney Docket No.	ARC9-2000-0100-US1

METHOD OF PAYMENT (check all that apply)

☐ Check ☐ Credit Card ☐ Money Order ☐ None ☐ Other (please identify): _____

☑ Deposit Account Deposit Account Number: No. 09-0441 Deposit Account Name: International Business Machines

For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)

☑ Charge fee(s) indicated below ☐ Charge fee(s) indicated below, **except for the filing fee**

☑ Charge any additional fee(s) or underpayments of fee(s) under 37 CFR 1.16 and 1.17 ☑ Credit any overpayments

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

FEE CALCULATION

1. BASIC FILING, SEARCH, AND EXAMINATION FEES

Application Type	FILING FEES Fee ($)	FILING FEES Small Entity Fee ($)	SEARCH FEES Fee ($)	SEARCH FEES Small Entity Fee ($)	EXAMINATION FEES Fee ($)	EXAMINATION FEES Small Entity Fee ($)	Fees Paid ($)
Utility	300	150	500	250	200	100	0
Design	200	100	100	50	130	65	0
Plant	200	100	300	150	160	80	0
Reissue	300	150	500	250	600	300	0
Provisional	200	100	0	0	0	0	0

2. EXCESS CLAIM FEES

Fee Description	Fee ($)	Small Entity Fee ($)
Each claim over 20 (including Reissues)	50	25
Each independent claim over 3 (including Reissues)	200	100
Multiple dependent claims	360	180

Total Claims	Extra Claims	Fee ($)	Fee Paid ($)
_____ - 20 or HP =	0	x 50	= 0

HP = highest number of total claims paid for, if greater than 20.

Indep. Claims	Extra Claims	Fee ($)	Fee Paid ($)
_____ - 3 or HP =	0	x 200	= 0

HP = highest number of independent claims paid for, if greater than 3.

Multiple Dependent Claims Fee ($)	Fee Paid ($)
360	0

3. APPLICATION SIZE FEE

If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)), the application size fee due is $250 ($125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

Total Sheets	Extra Sheets	Number of each additional 50 or fraction thereof	Fee ($)	Fee Paid ($)
_____ - 100 =	_____	/ 50 = _____ (round up to a whole number)	x _____	= 0

4. OTHER FEE(S)

	Fees Paid ($)
Non-English Specification, $130 fee (no small entity discount)	0
Other (e.g., late filing surcharge): Notice of Appeal + Appeal Brief (41.20(b)(1) and (2)	0

SUBMITTED BY

Signature		Registration No. (Attorney/Agent) 32,247	Telephone 408-323-5111
Name (Print/Type)	Samuel A. Kassatly		Date 12/08/2005

PTO/SB/21 (08-03)
Approved for use through 07/31/2006. OMB 0651-0031
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Application Number	09/617,455
Filing Date	07/17/2000
First Named Inventor	Reiner Kraft et al.
Art Unit	3622
Examiner Name	James W. Myhre
Attorney Docket Number	ARC9-2000-0100-US1

Total Number of Pages in This Submission

ENCLOSURES *(Check all that apply)*

- [x] Fee Transmittal Form
- [ ] Fee Attached
- [ ] Amendment/Reply
- [ ] After Final
- [ ] Affidavits/declaration(s)
- [ ] Extension of Time Request
- [ ] Express Abandonment Request
- [ ] Information Disclosure Statement
- [ ] Certified Copy of Priority Document(s)
- [ ] Response to Missing Parts/ Incomplete Application
- [ ] Response to Missing Parts under 37 CFR 1.52 or 1.53
- [ ] Drawing(s)
- [ ] Licensing-related Papers
- [ ] Petition to Revive
- [ ] Petition to Convert to a Provisional Application
- [ ] Power of Attorney, Revocation Change of Correspondence Address
- [ ] Terminal Disclaimer
- [ ] Request for Refund
- [ ] CD, Number of CD(s) _____
- [ ] After Allowance communication to Group
- [ ] Appeal Communication to Board of Appeals and Interferences
- [x] Appeal Communication to Group **(Appeal Notice, Brief, Reply Brief)**
- [ ] Assignment Recordation documents
- [ ] Status Letter
- [x] Other Enclosure(s) (please Identify below):

1) Certificate of Trasmission by Express Mail

Remarks

2) Return Postcard

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name	Samuel A. Kassatly
Signature	
Date	12/08/2005

CERTIFICATE OF TRANSMISSION/MAILING

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Typed or printed name	Samuel A. Kassatly		
Signature		Date	12/08/2005

Attorney Docket No.: ARC9-2000-0100-US1

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Signature

Samuel A. Kassatly
Typed or printed name of person signing Certificate

32,247
Registration Number, if applicable

408-323-5111
Telephone Number